

REMARKS

Applicants express appreciation to the Examiner for the Interview of April 18, 2001 conducted with Applicants' attorneys. The Office Action of January 31, 2001 rejected claims 1-29. By this paper, claims 5 and 9 have been canceled. Accordingly, claims 1-4, 6-8 and 10-29 are pending. Applicants respectfully request favorable reconsideration of the pending claims in view of the amendments made herein and the matters discussed at the interview.

The Office Action rejected claims 8-11 and 21-29 under 35 U.S.C. § 101 as being inoperative and therefore lacking utility. Specifically, the Office Action objected to determining the adjudication status of the claim "before the claim is submitted for processing." In response, Applicants have amended the claims to recite "submitted for adjudication" rather than "submitted for processing". Applicants respectfully submit that the claims as amended recite an operative invention and that the rejection under 35 U.S.C. § 101 has been overcome.

The Office Action rejected claims 1-7 and 12-20 under 35 U.S.C. § 102(b) as being anticipated by documents obtained by the Examiner from the Claimsnet.com website. Applicants respectfully submit that the documents from the Claimsnet.com website do not constitute prior art under 35 U.S.C. § 102(b) or under any other section of the statute. The Claimsnet.com documents do not indicate when they were publicly posted and do not indicate when the specific subject matter disclosed therein was publicly known or offered for sale. M.P.E.P § 2128, which governs the manner in which printed publications can be used as prior art during examination, states that:

Prior art disclosures on the internet or on an on-line database are considered to be publicly available as of the date the item was publicly posted. If the publication does not include a publication date (or retrieval date), it can not be relied upon as prior art under 35 U.S.C. § 102(a) or (b)

The Claimnet.com documents do not have a publication date, and presumably these documents were retrieved by the Examiner as part of a prior art search conducted in the days or months prior to issuance of the Office Action of January 31, 2001.

The Office Action purports to establish the date of the Claimsnet.com documents by reference to an article entitled "Claimsnet Files IPO To Fund Internet Service" published in the Dallas Business Journal, May 8th, 1998. The Office Action further indicates that this article states that Claimsnet has been offering services since 1996.

Applicants recognize that the Dallas Business Journal article has a publication date early enough to constitute § 102(a) prior art in the absence of swearing behind the article. However, the Office Action did not cite the article itself as prior art but used it to purportedly establish the date of the Claimnet.com documents. Moreover, Applicants point out that the Dallas Business Journal article has such little description of any of the services of Claimsnet so as to be not pertinent to the examination of the claims of the present application.

In summary, the Claimsnet.com documents have no publication date and do not indicate when the subject matter disclosed herein was publicly available and therefore does not constitute prior art.

In view of the foregoing comments, the rejection of the claims under § 102(b) has been overcome without the need to amend the claims. The Applicants have elected to amend the claims, nonetheless, in order to further clarify the claimed invention and to more particularly point out and distinctly claim the subject matter which Applicants regard as their invention. Thus, the amendments to the claims, other than the amendments made in response to the §101 rejection, are not being made for a substantial reason related to patentability.

Claim 1 as amended more distinctly recites the nature of the step of testing the adjudication status of the claim. In particular, claim 1 as amended specifies that the health care provider may know whether the claim is to be manually adjudicated by an adjudicator or whether the claim is to be automatically adjudicated. Similarly, the other independent claims have been amended to more distinctly recite the nature of the step of testing the adjudication status of the claim.

Finally, Applicants point out that the interview summary prepared at the conclusion of the interview of April 18, 2001, indicates that the proposal for the amendment of claim 1 overcomes the prior art of record and that the amended claims more particularly draw the distinction between the health care provider and the adjudicator of the claims.

The remarks above regarding the non-prior art status of the Claimsnet.com documents also apply to the other pending claims, including independent claims 8, 12, 21, and 29. Moreover, independent claims 8, 12, 21, and 29 have been amended to recite elements similar to those included in claim 1. For the foregoing reasons, Applicants respectfully submit that the pending claims are in condition for allowance.

Attached hereto is a marked-up version of the changes made to the previous version of the specification and claims by this amendment. The attached pages are captioned "VERSION WITH MARKINGS TO SHOW CHANGES MADE."

For the foregoing reasons, Applicants submit that the pending claims are in condition for allowance and courteously request favorable action. If there are any outstanding issues that could be resolved by telephone, the Examiner is invited to contact the undersigned attorney.

Dated this 1st day of May, 2001.

Respectfully submitted,

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